

Madrid System and the International Landscape



January 12, 2021



Diapositiva 1

JCD1

Jean-Claude Darné; 08-01-2021

INTA's Policy Priorities

- **Global Harmonization**
- **Anti Counterfeiting**
- **Brand restrictions**

Madrid Protocol

The International Landscape



International Expansion of the Madrid Community



1981: 9 members

1996: 50 members

2016: 97 members

2020: 107 members

At a Glance

1 application
1 set of fees
1 filing language



Centralized
Management
1.5 million
applications



107 members
80% of the world trade
and growing!



INTA's Position and Advocacy

INTA supports the Madrid Protocol as an option to

- Strategically protect & manage TM portfolios
- Efficiently and inexpensively reconcile global business with territorial nature

2017 Board Resolution supports reduction of pendency period from 5 to 3 years

Practice Guide available on INTA's website



Key Opportunities/Benefits

Time and cost effective

- Unifies fee payment
- Strict time limits

Simplified filing requirements

Simplified renewals, assignments, and recordals

Centralized portfolio management

Indirect harmonization



Main challenges

IPO's lack of capacity for timely response

- IPOs may not have enough resources and staff to handle the increase of work derived from the international applications

Language barrier

- 3 working languages: English, French, and Spanish

Decrease of direct applications by non-residents

- Reduction of trademark filings

Main challenges

It may be a tool for bad faith applications.

It may be a tool to extend cluttering and deadwood registrations.

Impact of the Madrid Protocol



Madrid Protocol in Asia

The Madrid Protocol has been well received in Asian countries

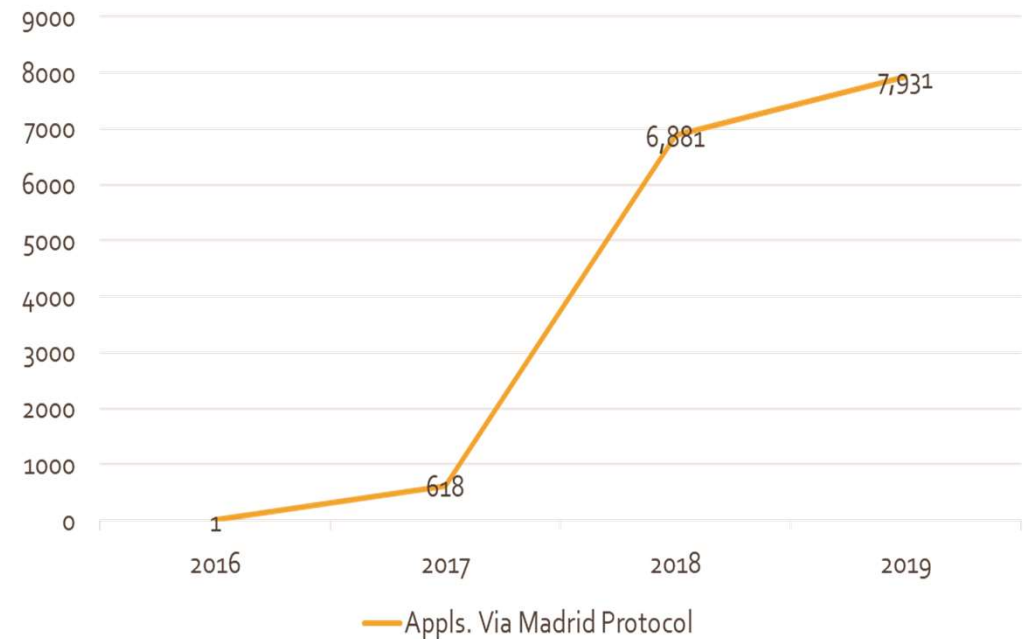
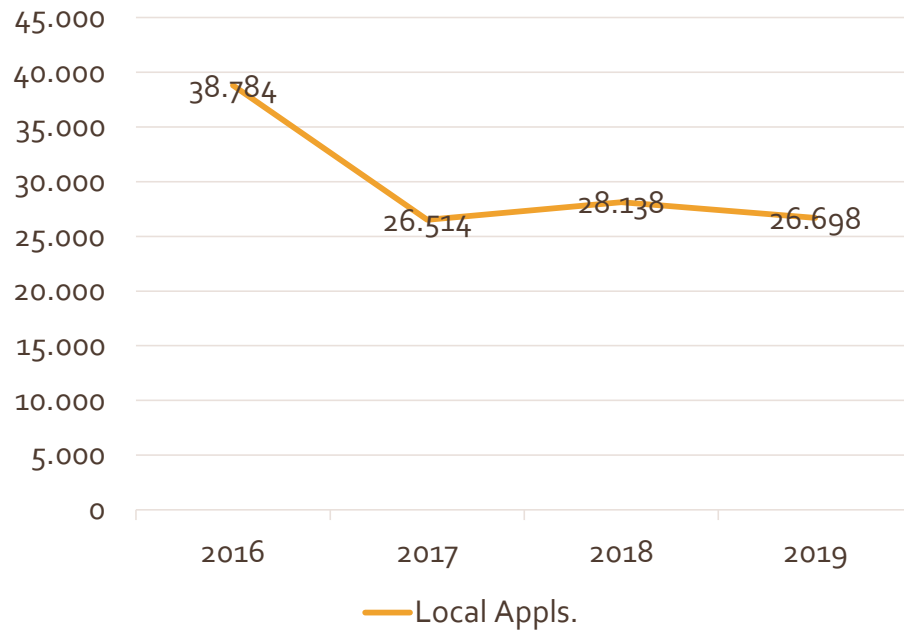
- In 2019, almost a quarter of all trademark registration applications came from Asia

Nearly all ASEAN member nations have joined Madrid



Madrid Protocol in Asia: The Thailand Experience

- Local applications decreased during the first 18 months of the implementation



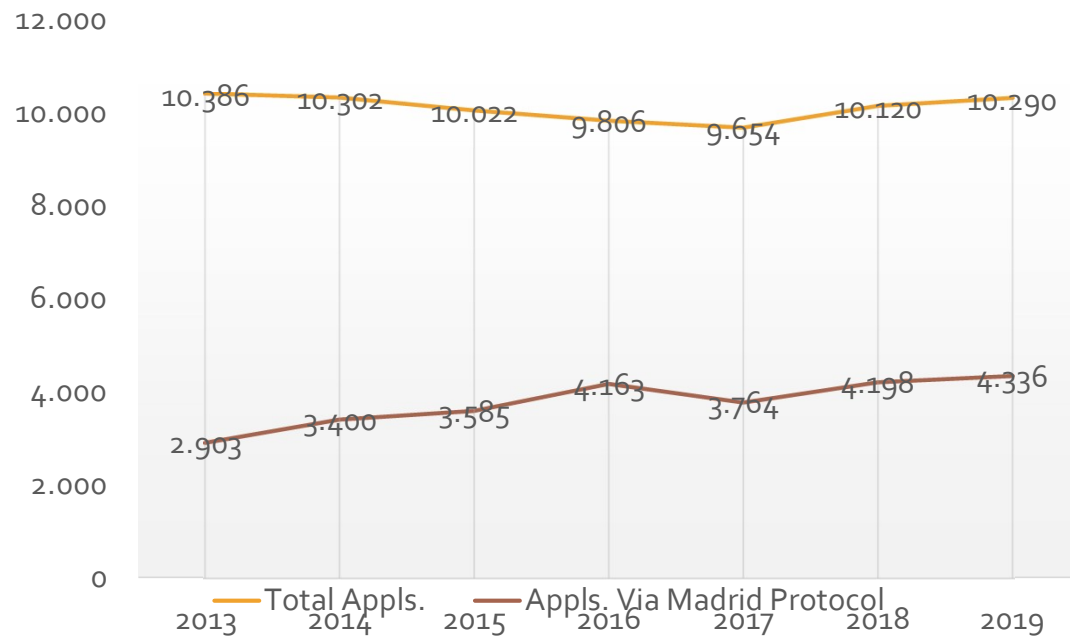
Madrid Protocol in Latin America & Caribbean

Members:

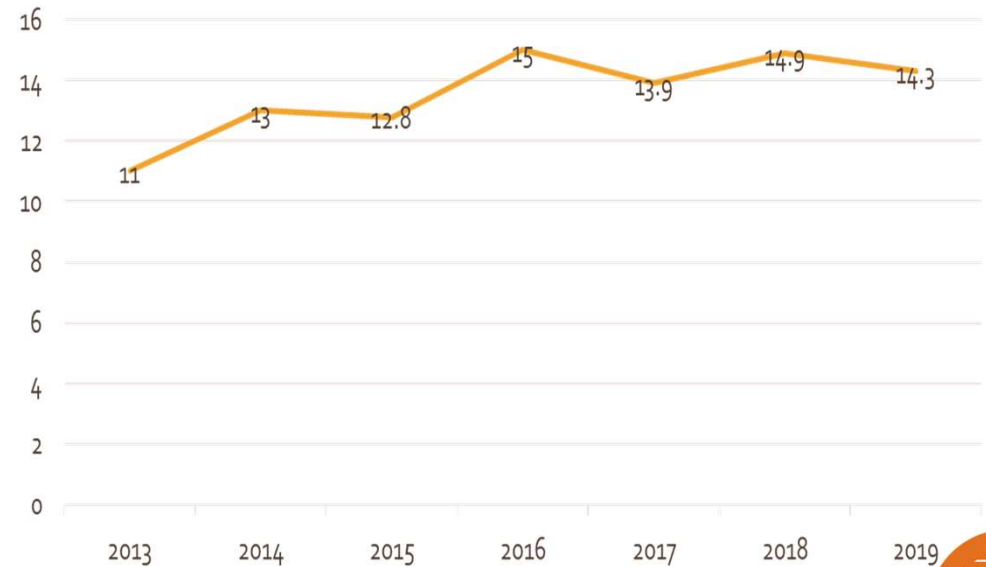
- Cuba: September 25, 1995
- Colombia: May 28, 2012
- Mexico: November 18, 2012
- Brazil: July 1, 2019
- Trinidad & Tobago: October 11, 2019

Madrid Protocol in Latin America: The Colombian Experience

Total trademark applications filed by non-residents



Percentage of trademark applications filed via the Madrid system

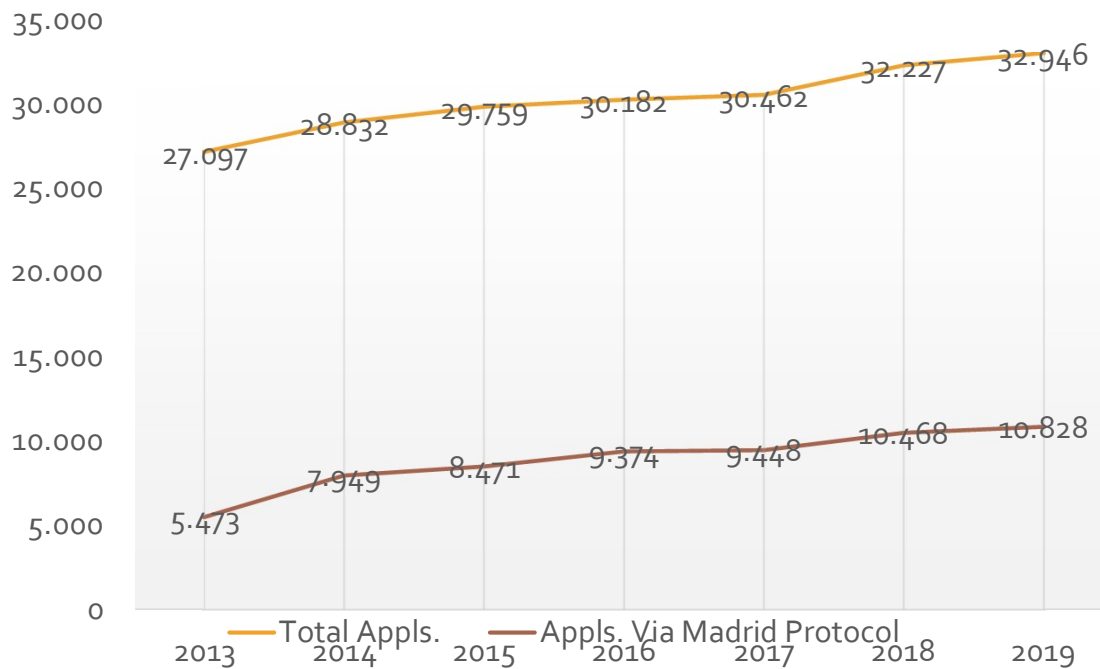


Source: WIPO IP Statistics Data Center

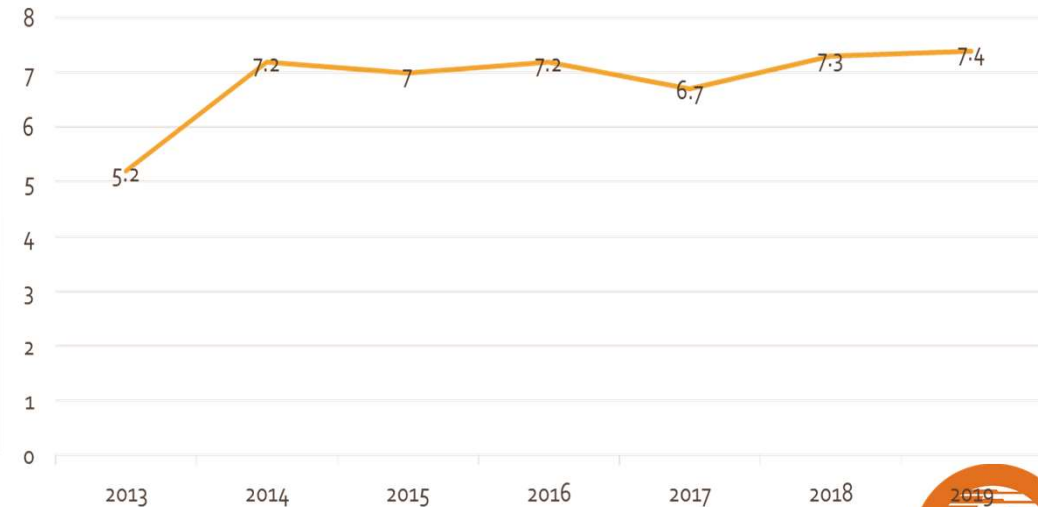


Madrid Protocol in Latin America: The Mexican Experience

Total trademark applications filed by non-residents



Percentage of trademark applications filed via the Madrid system



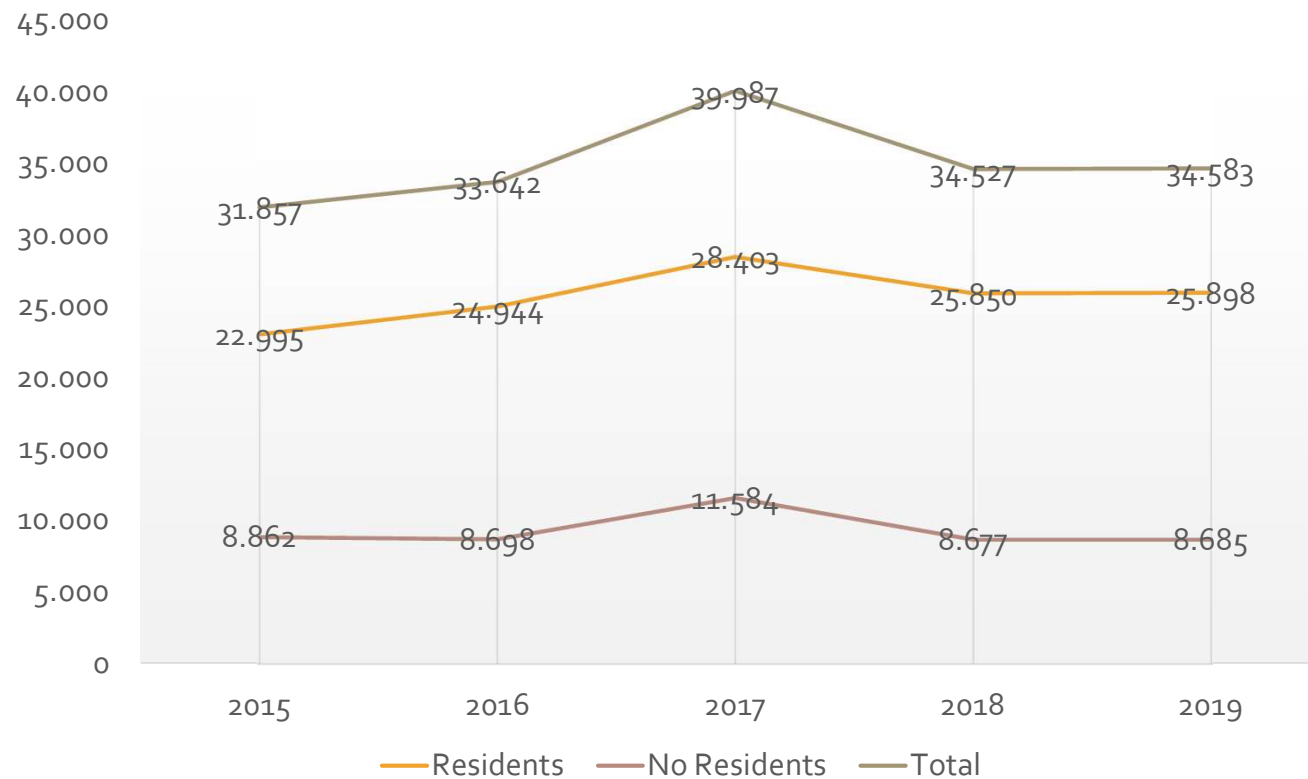
Source: WIPO IP Statistics Data Center



Madrid Protocol & Chile



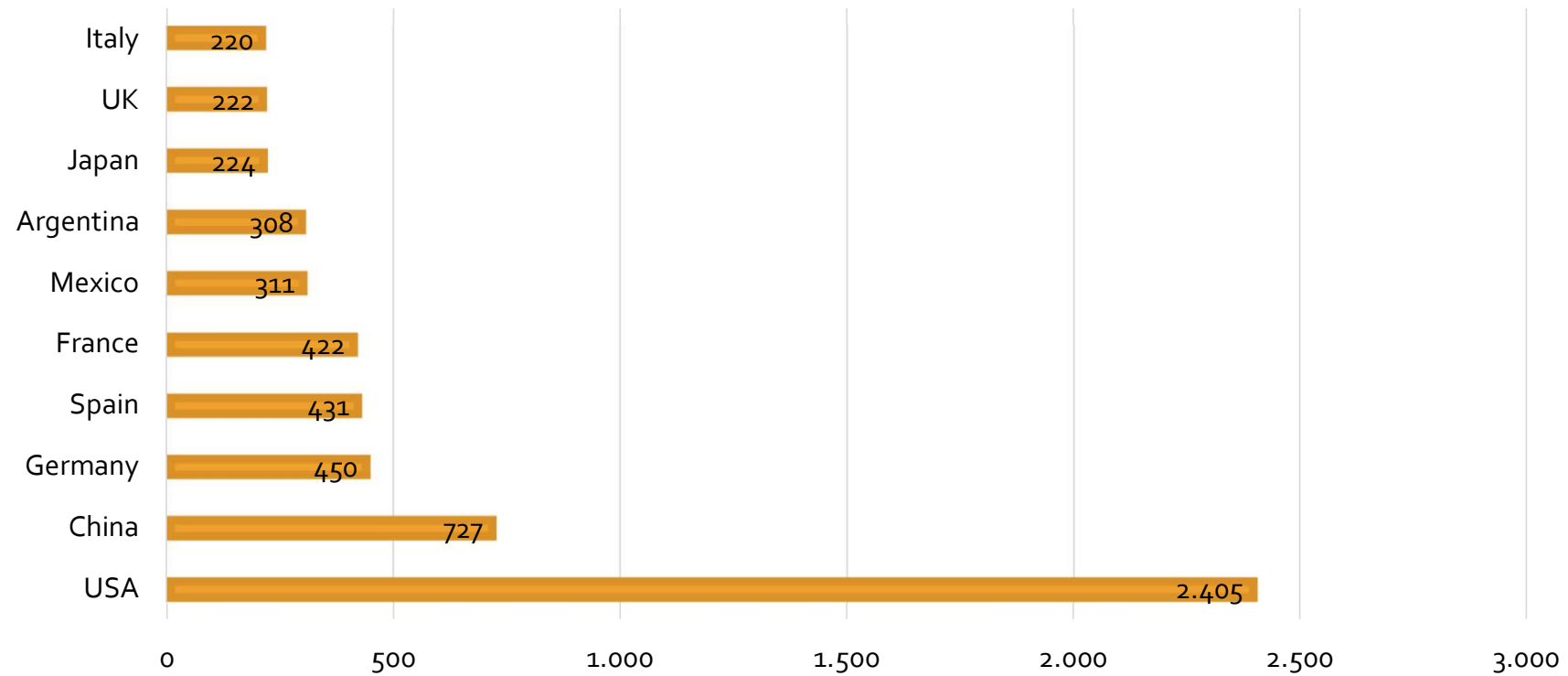
Total Trademark Applications in Chile: 2015 - 2019



Source: WIPO IP Statistics Data Center



Top 10 Trademark Filings by Country in Chile in 2019



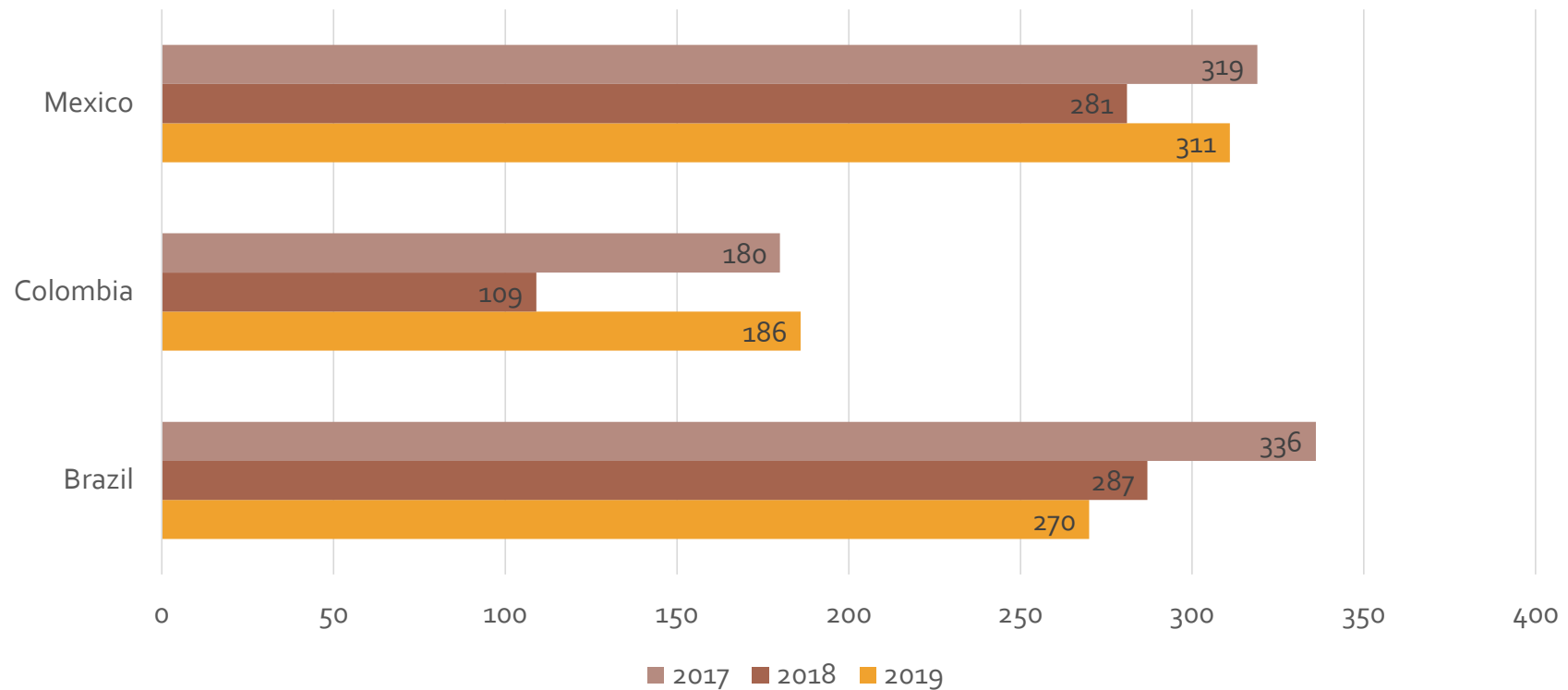
Source: WIPO IP Statistics Data Center



Non-Resident Filings in Chile

- Out of 8,685 trademark applications filed by non-residents, 5,720 come from the top 10 countries (as listed on the previous slide)
- Accounts for 66% of total trademark applications
- Of these countries only Argentina is not a member of the Madrid Protocol

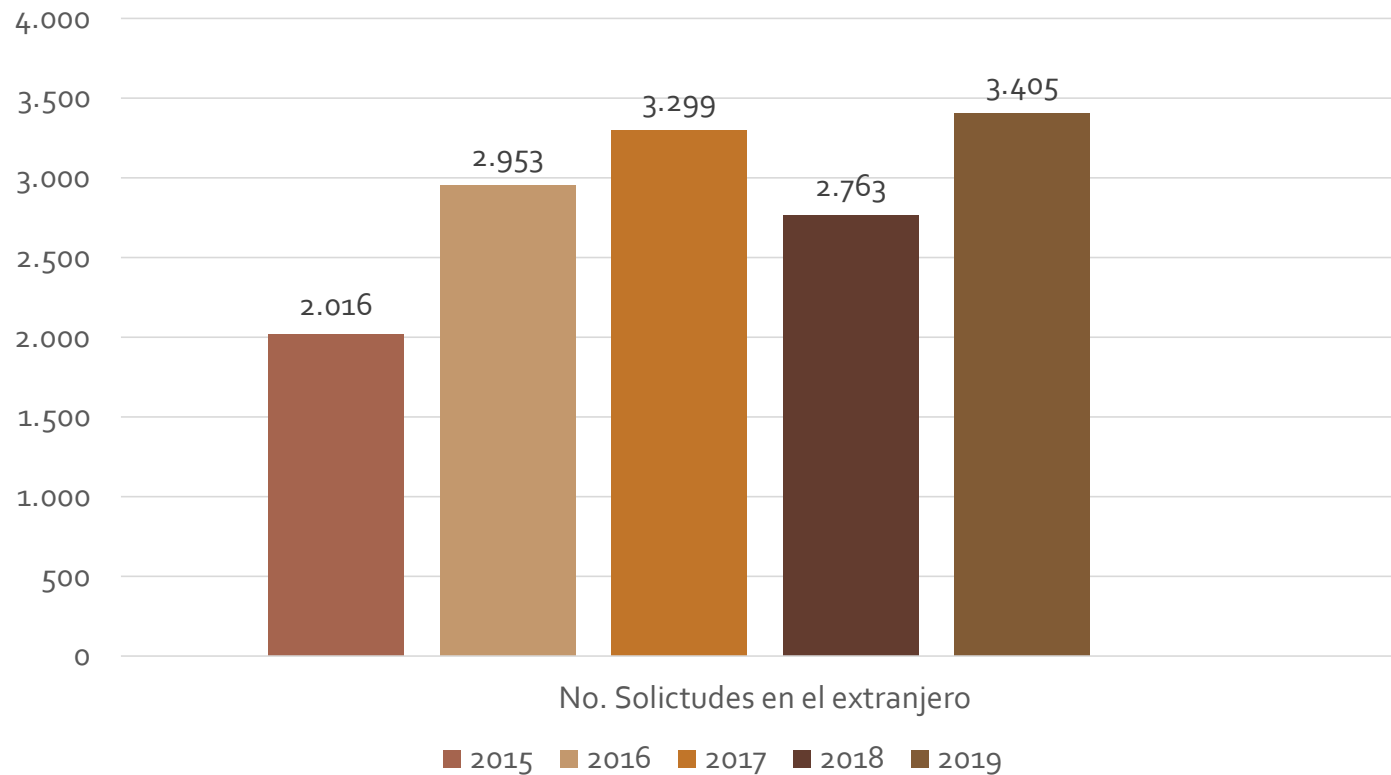
Applications from Latin American Countries that belong to the Madrid Protocol



Source: WIPO IP Statistics Data Center



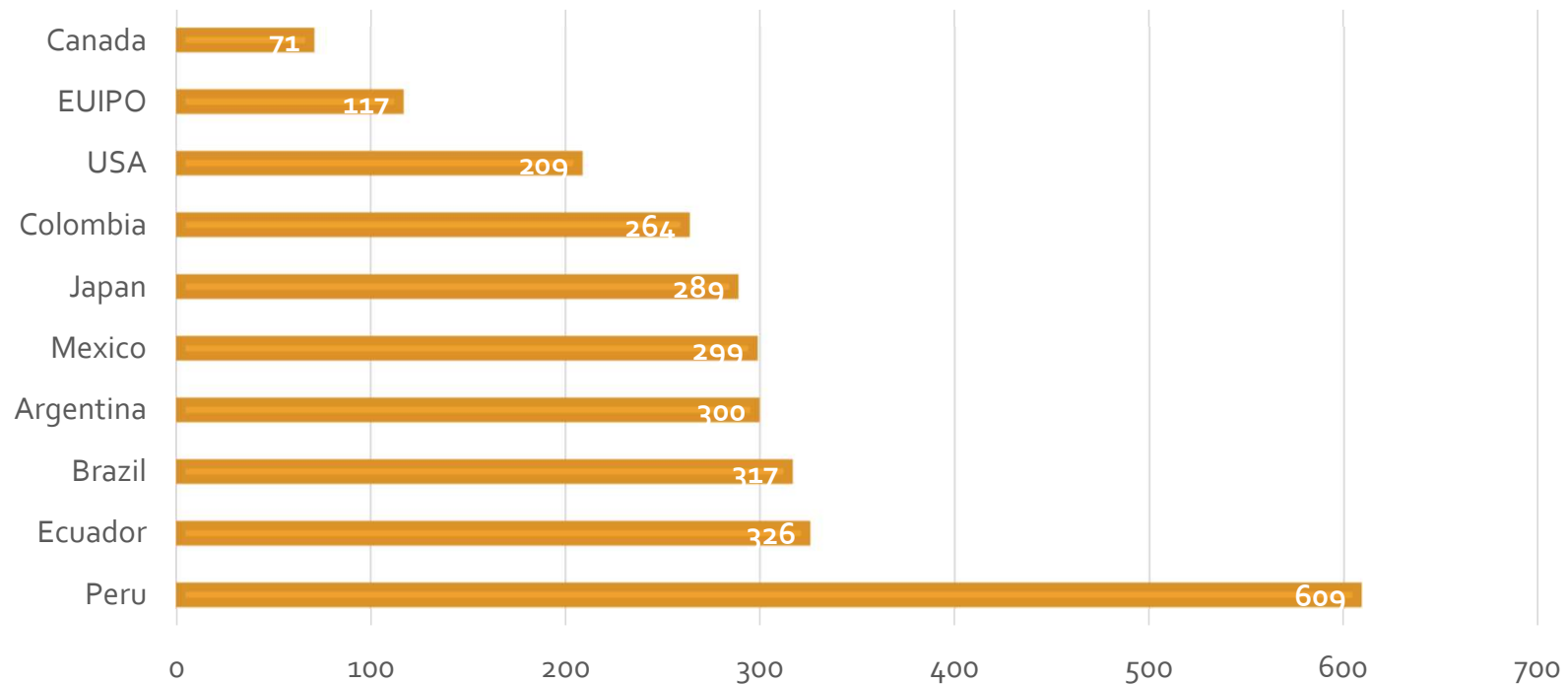
Applications from Chile to the World



Source: WIPO IP Statistics Data Center



Chilean International Trademark Applications in 2019



Source: WIPO IP Statistics Data Center



Chilean International Trademark Applications in 2019

- Of 3,405 trademark applications, 2,801 went to top 10 countries (82% of total)
- 3 of these 10 countries do not belong to the Madrid Protocol: Argentina, Ecuador, and Peru
- 880 trademark applications went to Latin American countries that belong to the Madrid Protocol: Brazil, Colombia and Mexico (almost 26% of total)

What Madrid Protocol should bring along

- **Cancellation of non used marks.**
- **Declarations/evidence of use to preserve TM rights and avoid deadwood registrations and/or cluttering,**
- **Protection of non traditional trademarks**
- **Madrid Protocol promotion among local companies.**

In Short: “The Short Law”

Looking to the Future

